

Docket No.: 085742-0496

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:  
Zhengming CHEN

Patent Number: 7,202,259

Application No.: 10/714,066

Filed: November 11, 2003

For: THERAPEUTIC AGENTS USEFUL FOR TREATING PAIN

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT**

**UNDER 37 CFR 1.705**

Mail Stop Patent Ext.  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is a request for reconsideration and recalculation of the patent term adjustment (PTA) under 37 CFR 1.705 for U.S. Patent No. 7,202,259, filed as Application No. 10/714,066 on November 11, 2003 and issued on April 10, 2007. This Request is accompanied by the \$200 fee required under 37 CFR 1.18(e).

37 CFR 1.705(d) requires that if the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section. Applicant believes that this request is timely because the two month deadline does not apply here. As stated below, the PTO miscalculated the PTA in the instant patent as a result of a misinterpretation of the "overlap" provision in 35 U.S.C. § 154.

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The PTO did not recognize its misinterpretation until the 2010 Federal Circuit decision in *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010). Thus, the PTO could not have, at the time the instant patent issued, indicated a revised PTA. The failure of the PTO to have indicated (or should have indicated) a revised PTA triggers the two-month deadline. There was no such trigger in this case.

The facts specifying the correct PTA and the bases under 1.702 for the adjustment are set forth below. The instant patent is not subject to a terminal disclaimer.

**Summary of Patent Term Adjustment under 35 U.S.C. § 154**

35 U.S.C. § 154 guarantees that the PTO will provide at least one notification under section 132 or a notice of allowance not later than 14 months after the date on which the application was filed, and subsequent notifications within four months of an applicant's response. PTO delays beyond these times are referred to as "A" delays.

35 U.S.C. § 154 further guarantees a no more than 3-year application pendency. This does not include time consumed by continued examination requested by the applicant. PTO delays beyond this 3-year period are referred to as "B" delays. PTO delays do not include "overlap" under 35 U.S.C. § 154(b)(2)(A). Applicant delay is deducted from the PTO delay to arrive at the PTA.

**PTO Practice Prior to *Wyeth***

Prior to the Federal Circuit's holding in *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010), the PTO interpreted "no overlap" under 35 U.S.C. § 154 to mean that any A

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delay would necessarily result in B delay. Thus, an applicant was entitled to a PTA equal to the greater of the two types of delay, but not both.

**The Correct Calculation under *Wyeth***

In *Wyeth*, the Federal Circuit stated that: “[n]o overlap happens unless the violations occur at the same time.” *Id.* at 1369-70. According to *Wyeth*, an applicant can be entitled to both A and B delays because no B delay occurs before the 3-year pendency date. Thus, there can be no overlap for A delays occurring before the 3-year pendency date.

**The PTO’s Old Calculation Deprived the Applicant of 148 Days of PTA**

The PTO calculated 350 days of PTA for the instant ‘259 patent. As illustrated below, the correct calculation under *Wyeth* is 498 days. A copy of the prosecution history, downloaded from the PTO’s PAIR database is attached as Exhibit A.

(a) A Delay

37 CFR 1.702(a)(1). The instant application was filed on November 11, 2003. The PTO mailed a Requirement for Restriction on March 14, 2006. The PTO Action was 425 days beyond 14 months from the filing date, resulting in a 425 day A delay.

(b) B Delay

37 CFR 1.702(b). The ‘066 application was filed on November 11, 2003. The Patent Issue Date was April 10, 2007. This resulted in a B delay of 148 days as follows.

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Three years from November 11, 2003 is November 11, 2006. The interval between November 11, 2006 and the April 10, 2007 Issue Date is 148 days.

(c) Overlap

37 CFR 1.703(f). The overlap is the period of A delay extending beyond the 3-year pendency date into the B delay period. Here, there is no overlap.

(d) Non-overlapped PTO Delay

The A+B delay, excluding overlap, is  $425 + 148 = 573$  days.

(e) Applicant Delays under 37 CFR 1.704

(i) Applicant delay was 46 days for the period in excess of three months from the Response to Restriction filed April 14, 2006 to the Information Disclosure Statement (IDS) filed May 30, 2006.

(ii) Applicant delayed 29 days for the period in excess of three months from the IDS filed May 30, 2006 to the October 6, 2006 Response After Non-Final Rejection.

(iii) The total applicant delay was  $46 + 29 = 75$  days.

**PTA under *Wyeth***

The correct PTA is  $573 - 75 = 498$  days.

**Conclusion**

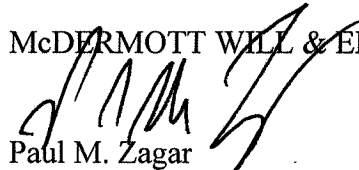
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As detailed above, the '259 patent should have been granted 498 days of PTA. The PTO, using the old, incorrect calculation method, granted 350 days of PTA. Thus, the applicant was deprived of 148 days of patent term adjustment it should have been accorded under the statute. Applicant respectfully requests reconsideration and recalculation of the PTA.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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# EXHIBIT A

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## Transaction History

Date	Transaction Description
11-03-2008	Change in Power of Attorney (May Include Associate POA)
10-30-2008	Correspondence Address Change
10-23-2008	Correspondence Address Change
04-10-2007	Recordation of Patent Grant Mailed
03-21-2007	Issue Notification Mailed
04-10-2007	Patent Issue Date Used in PTA Calculation
03-14-2007	Dispatch to FDC
03-03-2007	Application Is Considered Ready for Issue
02-26-2007	Issue Fee Payment Verified
02-26-2007	Issue Fee Payment Received
12-01-2006	Mail Notice of Allowance
11-29-2006	Notice of Allowance Data Verification Completed
11-29-2006	Case Docketed to Examiner in GAU
05-30-2006	Information Disclosure Statement considered
10-17-2006	Date Forwarded to Examiner
10-06-2006	Response after Non-Final Action
10-06-2006	Request for Extension of Time - Granted
05-30-2006	Information Disclosure Statement (IDS) Filed
05-30-2006	Information Disclosure Statement (IDS) Filed
06-07-2006	Mail Non-Final Rejection
06-01-2006	Non-Final Rejection
04-21-2006	Date Forwarded to Examiner
04-14-2006	Response to Election / Restriction Filed
03-14-2006	Mail Restriction Requirement
03-13-2006	Requirement for Restriction / Election
12-22-2005	Miscellaneous Incoming Letter
02-24-2005	IFW TSS Processing by Tech Center Complete
02-24-2005	Case Docketed to Examiner in GAU
04-23-2004	Application Return from OIPE
04-23-2004	Application Return TO OIPE
04-23-2004	Application Dispatched from OIPE
04-23-2004	Application Is Now Complete
04-08-2004	Additional Application Filing Fees
04-08-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant
02-12-2004	Notice Mailed--Application Incomplete--Filing Date Assigned
02-01-2004	Cleared by OIPE CSR
12-30-2003	IFW Scan & PACR Auto Security Review
11-13-2003	Initial Exam Team nn

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